

REMARKS

Claims 7, 11, 12, 13, 15, and 17 are pending in the above-identified application. Only independent claim 7 and 17 have been rejected, and claim 12 has a minor objection (which Applicant has repaired). The Office does not reject or object to any dependent claim, and thus the Action is not sufficient. Applicant requests allowance of all claims, but particularly all dependent claims since they are not objected to, or rejected, creating a presumption that they are allowable. When issuing a rejection, an Action must specify the pertinence of each reference to each rejected claim. See MPEP § 706; 37 CFR § 1.104(c). The present Action fails to demonstrate whether the cited references teach or suggest the features required by all dependent claims, but for claim 10. Because the Action has not demonstrated how each of the four references cited teaches or suggests all features of all claims, the Action has not shown such claim to be *prima facie* obvious in light of the four references cited.

Claim objections

Claim 12 has been amended as per the Examiner.

35 U.S.C. § 103 Obviousness Rejection of Claims

In the Action, the rejection of claims 7 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Narang (US 6,168,885) in view of Schneider (US 6,180,281) in view of Gozdz (U.S. Patent No. 5,840,087) in view of Kumeuchi (U.S. Patent No. 6,156,080). Applicant has also determined that Examiner discusses the limitation of claim 10 (temporal limitation of heating). Applicant cannot determine if the Office rejected each and every claim (as required by law and Patent Office practice), and does believe the Office did so.

The Examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the

claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

Although true, the motivation to combine a large number of references is less persuasive, than the combination of a smaller number. The Examiner has not shown why one skilled in the art would combine the particular features out of each complex patent cited to arrive at the instant invention. A large number of references, especially when those references teach complex subject matter, would not normally be combined to create a single invention, and the Office has failed in its burden to show such motivation, thus it must be presumed that Office has used impermissible hindsight reconstruction.

The rejection stated, in relevant part:

[...] It is submitted that the artisan would be motivated by the disclosure of Schneider et al. to form the electrolyte layers of Narang, et al. into a “seamless” layer.

(See the Action, page 3)

The invention is Narang is a fire retardant technique, thus why one skilled in the art would be motivated to read the disclosure in Narang and select the specific passages that Office is citing is lacking.

Further, the Office admits on page 3 of the current the Action that the Narang reference does not specifically teach wound sheets, or a “seamless” layer, or that both sides are of each electrode are coated. Since each and every limitation of a claim must be taught in order to be anticipated as novel or obvious, the motivation to combine Narang with a large number of other references in order to find each limitation would only be done in hindsight, or alternatively, was only obvious to try.

The Office argues that the patent of Schneider teaches another limitation, namely “seamless” electrode layers. Although generally discussed as the boundaries having “merged”

the Office has not shown that these boundaries are “seamless.” A “generalization” is not sufficient to support a rejection. The MPEP clearly states (at 706.02(j)) that:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the **reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.** *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (emphasis added).

The Office then further cites Godzsz in support of the laminating of electrolyte layers. Godzsz teaches rolling between plates, and thus not only does not teach the instant claims, it also teaches a completely different process. Why would one skilled in the art look to a patent directed to a rolling process in order to gain motivation to laminate layers in a completely different way?

Finally, the Office cites a fourth patent in order to support this obviousness rejection. Kumeuchi is cited for the winding limitation. Although this reference does teach this limitation, the Office has not provided a viable reason to combine this reference with the other three, the Office states “the artisan would be motivated” but states no direct motivation. A general supposition that one skilled in the art would be motivated is insufficient to support an obviousness rejection. MPEP 2143.01. The Office also claims it is obvious to coat both side to prevent a short circuit, but presents no evidence for this broad general characterization.

The Examiner nowhere discussed or shows how this combination, which the Examiner has worked diligently to construct in hindsight, would have had any reasonable chance of success - much less why any skilled practitioner would have combined these references in the first place. The Applicant hereby requests allowance of claims 7 and 17.

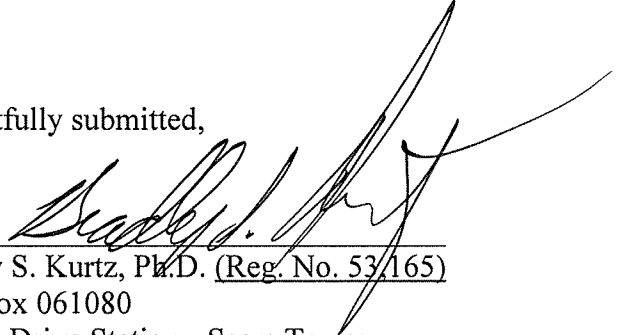
Finally, Examiner rejects claim 10 (temporal limitation of heating) by citing “30 minutes or less” as invalidating the ten minute limitation of claim 10. First, this is not anticipating as the heating time must be more than zero minutes. The “30 minutes or less” limitation within Kumeuchi is indefinite. Kumeuchi does not teach a lower limit, but it is obvious that there must be one. The instant Application teaches a species that functions well within that genus and is allowable as Kemeuchi is indefinite - and thus cannot specifically teach any lower limit. The Applicant hereby requests allowance of claim 10.

Lack of rejection of dependent claims has created a presumption of allowability

Finally the Office should withdraw the Action, as the Office provides no basis for rejection of each and every dependent claim herein. It is not sufficient to reject independent claims, and not refute and each and every limitation in the claims dependent thereto. Applicant forwards that the lack of objection or rejection of dependent claims to film packs, such as claim 14 and 15; solvents in claim 13, and the other dependent claims herein has created a presumption that those claims are allowable if written in independent form. MPEP 707.07(j). Applicant respectfully requests an allowance to that effect, or a rejection describing why they are not allowable. Applicant also requests that any Office Action rejecting those claims be non-final as Applicant deserves the opportunity to respond fully to these new rejections. As stated in MPEP 2164.08, “The examiner should determine what **each** claim recites and what the subject matter is when the claim is considered as a whole, not when its parts are analyzed individually. **No claim should be overlooked.**” (emphasis added).

It is submitted that Applicant has overcome the rejection. Even if the Office insists that the rejection is maintained, the dependent claims present allowable subject matter. In view of the foregoing, Applicants submit that the application is in condition for allowance. Notice to that effect is requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Bradley S. Kurtz', is written over a horizontal line. The signature is stylized with a large, sweeping 'B' and a long, horizontal stroke extending to the right.

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